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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/733,737

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Cynthia Ann Adiano

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EXAMINER

WRIGHT, NORMAN M

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,737

Applicant(s)

ADIANO ET AL.

Examiner

Norman M. Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/18/00.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____


NORMAN M. WRIGHT
PRIMARY EXAMINER

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DETAILED ACTION

1. Claims 1-45 are present for examination.
2. The examiner requests, in response to this Office action, any reference(s) known to qualify as prior art under 35 U.S.C. sections 102 or 103 with respect to the invention as defined by the independent and dependent claims. That is, any prior art (including any products for sale) similar to the claimed invention that could reasonably be used in a 102 or 103 rejection. This request does not require applicant to perform a search. This request is not intended to interfere with or go beyond that required under 37 C.F.R. 1.56 or 1.105.

The request may be fulfilled by asking the attorney(s) of record handling prosecution and the inventor(s)/assignee for references qualifying as prior art. A simple statement that the query has been made and no prior art found is sufficient to fulfill the request.

In the event prior art documentation is submitted, a discussion of relevant passages, figs. etc. with respect to the claims is requested. The examiner is looking for specific references to 102/103 prior art that identify independent and dependent claim limitations. Since applicant is most knowledgeable of the present invention and submitted art, his/her discussion of the reference(s) with respect to the instant claims is essential. **A response to this inquiry is greatly appreciated.**

The examiner also requests, in response to this Office action, support be shown for language added to any original claims on amendment and any new claims. That is,

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indicate support for newly added claim language by specifically pointing to page(s) and line no(s). in the specification and/or drawing figure(s). This will assist the examiner in prosecuting the application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olkin et al., U.S. Pat. No. 6,584,564 and Leonard et al., U.S. Pat. No. 6,721,784, hereinafter respectively '564 and 784.

5. As per claims 1, '564 teach a method for secure electronic distribution of software media files (fig. 3 and col. 5, lines 42 et seq.) over networks comprising: e-mail as a delivery mechanism (abs., figs. 2b, 3, 5, 6a, col. 3, lines 30-45 et seq., appending as an attachment/file/media/data (col. 14, lines 36 et seq.), e-mail message, opening, installing (figs. 3, 5, 8, col. 4, lines 17-25 et seq.), marking (fig. 6c) and storing said files on a recipients computer (fig. 6a-b, col. 4, lines 35 et seq.). It does not teach marking the e-mail as used to prevent further installations/desired events.

6. '784 teach saving and marking media files to prevent disable further installations/events (abs., figs. 3-8, col. 6, lines 20-35 et seq.). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the

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software distribution of '564, with a means of enabling and controlling the distribution of an electronically transmitted message, an e-mail attachment, as disclosed by '784. One of ordinary skill in the art would have been motivated to perform such a modification, because, one of ordinary skill in the art would have realized that the originator of a e-mail message might desire to control the distribution and viewing of the content of said e-mail data as a way of safe guarding the data against unauthorized use and/or distribution (col. 3, lines 50 et seq., and col. 6, lines 20 et seq.) A person of ordinary skill in the art, desiring not to have a user exceed his authority to use or distribute an email and its data would have desire to implement a means of ensuring that the user and system afforded some means of preventing a specific event/installation from occurring. A skilled artisan with such a desire in mind, would have viewed the invention of '784 as a means of adding access control and security features to the e-mail system, while still making the data readily available.

7. As per claims 2-4, determining if previously installed/read, determine mail recipient is on a db, number reads/installations (message keys, max reads, use and registry tables, figs. 2-3, col. 9, lines 25 et seq., figs. 5, col. 10, lines 25 et seq.).

8. As to claims 5-6, determining if successfully save files, unsuccessful installation, '784 uses special handling instructions as part of the installation process, failure to follow these instruction results in either nullification of the installation process or termination/failure (col. 18, lines 16-40 et seq.).

9. As to claim 7, the encrypting of a serial number of the storage device in a registry, '784 require that specific processes and events are followed as part of the

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installation process, it does teach utilizing an encrypted form of the serial number as a part of registering process for installation. It does, however, teach that the installation data maybe stored either locally or remotely, see figs. 6, 9, and 16, and col. 16, lines 44 et seq.. The examiner takes official notice of both the motive and modification necessary for having a local processor store its identifying information/serial number/machine identity in an encrypted registry as part of a validation/installation process. '564 is being recited as support for the taking of official notice, see fig. 5, col. 8, lines 40-45 et seq., and lines 60-67 et seq., col. 10, line 25 et seq.. It would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the installation and verification processes of '784 with an applet subroutine as taught by '564, for enabling the installation and verification process to having a registry that has identifying information that is machine or computer specific and dependent. One of ordinary skill in the art would have been motivated to perform this modification, because, one would have had a desire to ensure, that after supplying a secured e-mail or application, that the data or program was not inappropriately stored or used on a machine for which it was not intended. A person of ordinary skill would have chosen this or any other well proven method of protecting data as a means of providing additional steps in protecting their data or program, as suggest by '784 at abs., col. 1, lines 20-45, col. 3, lines 50 et seq., and col. 6, lines 20-34. '564 also indicates that the user may have various installable options associated with an applet to permit registration, see '564 at col. 4, lines 35 et seq., col. 6, lines, 13 et seq., and col. 8, lines 17-27 and 40-65 et seq..

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10. As to claims 8 and 10, it distinguishes over rejected claims 1-7 by reciting that it is invoked from a storage/device/disk drive location etc., and decrypted comparing the serial/machine/client identification before allowing execution. As indicated above, by the modification of '784 with '564, the decryption would occur upon successfully meeting the registration process called for by '784 and then execution would occur, see also '784 figs. 3,6-9 and 12. If registration was still unsuccessful than termination/stop would occur because the user failed to comply with the installation requirements (col. 18, lines 35 et seq.).

11. As to claim 9, that the reinstallation be tried upon a condition of a failure, this is not taught by '784. The examiner takes official notice of both the motive and modification necessary for having one of the specific events for installation being that of a retry upon an unsuccessful installation/download. It would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the installation and verification processes of '784 with an applet subroutine that would allow retry upon unsuccessful installation and verification process failures. One of ordinary skill in the art would have been motivated to perform this modification, because, computers vendors frequently make use of retries in the event of unsuccessful installation of computer program products. A person of ordinary skill would have been motivated to further augment the applets, because, the retry is a proven and effective method of re-installing a product that has not been successfully installed.

12. As to claims 11-20 they distinguish over the previously rejected claims 1-10 by reciting a computer program product. '784 teaches that his invention may be

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implemented as a program (claims 1-5), and '564 teach using software modules (26), or applets which, must inherently be stored on a computer readable medium prior to use in a computer system or as a CD (col. 8, lines 30 et seq.).

13. As to claims 21-45 they recite the previously concomitant elements in a system and therefore are rejected under the same rationale as claims 1-20 above. Accordingly, see above for the specifics of the rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norman Wright whose telephone number is (751) 272-3844. The examiner can normally be reached on Mondays - Thursdays from 9am to 4pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).


NORMAN M. WRIGHT
PRIMARY EXAMINER